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FULBRIGHT & JAWORSKI, LLP				
666 FIFTH AVE				
NEW YORK, NY 10103-3198				
EXAMINER				
DANIELS, MATTHEW J				
ART UNIT		PAPER NUMBER		
1791				
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11/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/507,402

Applicant(s)

HORSTING ET AL.

Examiner

MATTHEW J. DANIELS

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CD/CD)
Paper No(s)/Mail Date 9/13/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, Claims 12-18 in the reply filed on 18 July 2008 is acknowledged. The traversal is on the ground(s) that no objection to lack of unity was raised in the PCT phase. This is not found persuasive because the International Search Report does not address the Rohrbacher reference cited as a basis for showing the absence of a special technical feature. The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

2. The information disclosure statement filed 13 September 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 12-18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **Claim 12** recites that the film may already display the "final desired properties" with regard to the structure. However, the rest of the claim contradicts this limitation by

suggesting that the “final desired properties” are actually produced by molding some reinforcement against the back of the sheet. Additionally, the claim recites a step of “placing a plastics (sic) material film on a mold which displays the topography of the surface of the structural part”, but omits the essential step of forming or preforming the film prior to the later step of “inserting the preformed film into a corresponding mold”. Claims 13-18 are rejected by dependence, but revision is suggested to clarify the meaning of “reinforced-reinforced plastics material” in Claims 12-14 and “refined” in Claims 16-18.

International Search Report

4. The Rohrbacher reference has been selected as the base reference because it teaches the sheet molding compound of Claim 14 in additional to all features of independent Claim 12, and is therefore believed to be the most pertinent reference with respect to the instant claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 12, 14, and 16** are rejected under 35 U.S.C. 102(b) as being anticipated by Rohrbacher (USPN 4959189). **As to Claim 12**, Rohrbacher teaches fabricating a structural part made of reinforced material that may be deformed by thermal molding comprising: placing a plastic film (3:22) in a mold (Fig. 5, item 18) which displays the topography of the surface of the

structural part (4:33-44) such that the film displays the final desired shape, structure, and color (4:18-21 and 4:44), inserting the preformed film into a corresponding mold (Fig. 5) with saturated fiber mat (Fig. 5, item 1 and 9:32-48) against a side which is not the surface, molding the SMC onto the film (4:45-58) and hardening (curing, 4:49-52) to form a composite material which is subsequently removed from the mold. Cooling would have been inherent because the material would obviously be cooled from its elevated molding temperature (140 to 160 C) before subsequently using the article for its intended purposes (4:54-58). **As to Claim 14**, Rohrbacher provides a sheet molding compound (SMC, Abstract). **As to Claim 16**, the surface of the structural part of Rohrbacher has a coating layer (3:25-30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 13 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbacher (USPN 4959189). Rohrbacher teaches the subject matter of Claim 12 above under 35 USC 102(b). **As to Claim 13**, Rohrbacher depicts the preformed film (16) and sheet molding compound (1) comprising thermoset material placed in the mold, wherein the sheet molding compound is placed on the second mold half, and connecting the two in a pressing process (inherent). It is unclear if Rohrbacher teaches the claimed placement of the preformed film on the other mold face, as claimed. However, it would have been obvious to place the film on the

second mold half since (a) there are a finite number of placement options (on the second mold half, suspended, or against the sheet molding compound) and one would have found it obvious to explore each of these options, and/or (b) placement against the second mold half would have provided maximum adjustability until the point of compression. **As to Claim 18**, Rohrbacher clearly teaches that the surface of the material has a coating with an effect color (Fig. 2, item 4), but the coating is merely applied prior to integrating the sheet with a sheet molding compound. While Rohrbacher is silent to the coating of the article after molding, this is merely an obvious rearrangement of process steps already disclosed by the prior art. One practicing the Rohrbacher process would have found it obvious that the article could simply be coated after molding the sheet molding compound.

7. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbacher (USPN 4959189) in view of Graefe (US 5,074,770). Rohrbacher teaches the subject matter of Claim 12 above under 35 USC 102(b). **As to Claim 15**, Rohrbacher teaches a preformed sheet inserted into a mold (Fig. 5), a fiber mat placed under the cavity of the film, and the mold is closed until a resin hardens (4:49-51). Rohrbacher is silent to the injection of the resin. However, in a first view this is merely a rearrangement of prior art process steps since Rohrbacher teaches applying resin to fibrous material before placing the fibrous material in the mold. However, one would have found it obvious to apply the resin to the fibrous material at any point in the process. Additionally or alternatively, Graefe teaches a process in which a film is placed in a mold (Fig. 5, item 16), a fibrous layer is placed behind it (Fig. 5, item 30), and resin is injected after closing the mold (8:5-6). The injected resin contains a catalyst or initiator

(13:10-15) which would act as a hardener when combined with the resin. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Graefe into that of Rohrbacher because (a) Rohrbacher clearly suggests that a combination of resin and fiber should be applied against the backside of a film, and Graefe provides a process for applying a resin and fiber material against the backside of a sheet, or (b) one of ordinary skill would have recognized the resin injection of Graefe as an obvious alternative or substitute for the use of a sheet molding material disclosed by Rohrbacher to provide the same result, namely a facing sheet with reinforced backing material.

8. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbacher (USPN 4959189) in view of Furuya (US 6,150,026). Rohrbacher teaches the subject matter of Claim 12 above under 35 USC 102(b). **As to Claim 17**, Rohrbacher does teach a film comprising a color layer (Fig. 2), however, Rohrbacher is silent to coextrusion. Furuya teaches that it is known to provide a film useful in an exterior panel by coextrusion lamination (col. 12) before performing the skin and molding material against the back surface. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Furuya into that of Rohrbacher since one of ordinary skill would have recognized the Furuya coextrusion process as a substitutable or alternative process for achieving or fabricating the film material to be preformed in the Rohrbacher process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. DANIELS whose telephone number is (571)272-2450. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J. Daniels/
Primary Examiner, Art Unit 1791
11/8/08